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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,419	05/11/2001	Thomas J. Moravec	589.102US1	7680

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EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/854,419	Applicant(s) MORAVEC ET AL.	
	Examiner Travis B Ribar	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12 and 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 and 13-19, drawn to a photochromic element and a method of making the element, classified in class 428, subclass 412.
 - II. Claims 10-11, drawn to a method of forming a photochromic element, classified in class 156, subclass 60.
 - III. Claims 20-28, drawn to a method of making an ophthalmic lens, classified in class 427, subclass 372.2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process, such as sandwiching a layer of the film between two polymeric layers while still wet.

3. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

the instant case the different inventions represent unrelated methods of making a material.

4. Inventions I and III represent separate and patentably distinct inventions. Specifically, the method for making the ophthalmic lens in invention III has issues of patentability not present or related to invention I, such as the inclusion of a hardenable resin to make an ophthalmic lens.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Mr. Mark Litman on August 28, 2002 a provisional election was made with traverse to prosecute the invention of group I, claims 1-10 and 13-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11, 12, and 20-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3, 9, and 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 3, it is unclear from the language of the claim what the scope of the claim is. The phrase, "consisting of" in line 1 indicates closed language, but it is followed by the phrase, "comprising" in line 2. For the purposes of this examination, this claim will be presumed to mean that the claimed structure at least three layers.

11. Claims 13-19 recite the limitation "laminable article". There is insufficient antecedent basis for this limitation in the claim. This claim will be read as, "laminable photochromic element" for the purposes of examination.

12. Regarding claim 9, it is unclear from the language of the claim what laminate structure the applicant is claiming. The phrase, "...the polymeric layer..." bridging lines 3 and 4 renders the claim unclear because there are two polymeric layers present in the laminate structure. For the purposes of this examination, this claim will be read as, "...one of the polymeric layers..." If this language is not changed, there could be a future issue of antecedent basis with the term "...the polymeric layer..."

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

14. Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowles, III et al.

Bowles, III et al. discloses a photochromic polyurethane coating that is coated on a polycarbonate substrate (column 2, lines 55-56 and column 14, line 39). The polyurethane is a polyester polyurethane, as it is made from a polyester polyol (column 3, line 64 and column 7, line 31) and a polyisocyanate compound. The invention thereby meets all of the requirements of claim 1. The photochromic polyurethane coating is further coated with an abrasion resistance coating, meeting the applicant's claim 8.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1711

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-10 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhalakia et al. in view of Ormsby et al.

Bhalakia et al. discloses a multifocal optical lens that includes the general laminate structure of the present invention – up to two polycarbonate sheets (column 4, line 59) that have a multilayer functional film (column 5, lines 7-10), such as a photochromic film, sandwiched between them (column 4, lines 11-15). These are restrictions in the applicant's claims 1-3. The multilayer functional film is securely adhered to a the polymeric substrates (the article in the present claims) via lamination (column 4, lines 11-15), meeting this method requirement in claims 13-19.

Bhalakia et al. teaches that the polycarbonate sheets can be in the form of ophthalmic lenses (column 4, line 59), which meets this restriction in claims 6 and 7, and may also include an anti-abrasion coating (column 6, lines 55-58 and column 7, line 2), meeting this part of claims 8-10.

Claims 4 and 5 are product-by-process claims. In product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102 or 103 rejection made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. The applicant has not shown that the method by which the product is made causes the product to be patentably distinct from the product produced by the reference(s). Specifically, any structure that contains the elements in claims 4 and 5 where the laminable photochromic element is securely deposited on a polymeric

Art Unit: 1711

surface will be the same as the element in these claims, regardless of if they are or are not fused or adhesively secured to the substrate. This rejection under 35 U.S.C. 103 is therefore proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Bhalakia et al. does not, however, meet the material restriction of claim 1 which includes a polyester urethane binder and a photochromic compound, though it does note that the composition of the functional portion of the invention may be changed to suit various applications (column 19, lines 63-66).

Ormsby et al. shows a polyurethane binder that includes photochromic compounds (column 4, lines 3-12). The polyurethane binder is a polyester urethane, made from polyester diols and polyisocyanates (column 3, line 41), and is used in ophthalmic lenses (column 2, lines 60-61) as part of a multilayer laminate structure (column 2, lines 56-59). This meets the compositional requirements for the polyurethane binder in the applicant's claim 1.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the photochromic polyurethane composition in Ormsby et al. in the functional layer in Bhalakia et al. or the multilayer structure in Ormsby et al. as the functional layer in Bhalakia et al. The motivation for doing so would be that the photochromic polyurethane composition in Ormsby et al. is known to be a good intermediate layer for photochromic lenses. Therefore it would have been obvious to combine Ormsby et al. with Bhalakia et al. to obtain the invention as specified in claims 1-10 and 13-19.

17. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhalakia et al. in view of Bowles, III et al.

Bhalakia et al. is applied to the present application as disclosed above, but does not include the polyester urethane binder that the applicant claims. Bowles, III et al. is also discussed above, and includes the polyester urethane as a binder in a photochromic coating useful on lenses.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the coating in Bowles, III et al. on the lens taught in Bhalakia et al. The motivation for doing so would be that the coating would be to provide photochromic properties to the lens in Bhalakia et al. Therefore it would have been obvious to combine Bowles, III et al. with Bhalakia et al. to obtain the invention as specified in claims 1 and 8.

18. Claims 1-10 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhalakia et al. in view of Rosthauser et al.

Bhalakia et al. and its deficiencies are discussed in paragraph 16 of this office action. Rosthauser et al. discloses a polyester urethane binder (column 3, lines 8-40) that contains a photochromic compound (column 4, lines 16-24). The polyester urethane composition is used in ophthalmic lenses (column 1, lines 19-2), among other uses.

Art Unit: 1711

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the photochromic polyurethane composition in Rosthauser et al. in the functional layer in Bhalakia et al. The motivation for doing so would be that the photochromic polyurethane composition in Rosthauser et al. is known to be a good intermediate layer for photochromic lenses. Therefore it would have been obvious to combine Rosthauser et al. with Bhalakia et al. to obtain the invention as specified in claims 1-10 and 13-19.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar
Examiner
Art Unit 1711

TBR
September 2, 2002

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700